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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,069	09/09/2003	Eugene P. Marsh	M4065.0453/P453-B	9190
24998	7590	01/20/2006	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			LEWIS, MONICA	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	
			2822	

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/657,069

Applicant(s)

MARSH ET AL.

Examiner

Monica Lewis

Art Unit

2822

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that Soininen fails to disclose "at least one of said first and second capacitor electrode comprising a continuous ALD deposited rhodium film with substantially pure metallic rhodium composition" and "substantially pure metallic rhodium formed by rhodium atomic layer deposition of dicarbonyl cyclopentadienyl rhodium at a temperature of about 100oC to about 200oC." However, Soininen discloses a first electrode (36) and a second electrode (40) and at least one of said first and second electrode comprising rhodium film (For Example: See Figure 2 and Column 5 Lines 5-15). "A continuous ALD deposited rhodium film" and "a substantially pure metallic rhodium layer formed by rhodium atomic layer deposition of dicarbonyl cyclopentadienyl rhodium at a temperature of about 100oC to about 200oC" are product by process limitations. "Applicants reaffirm that the limitation...is not a product-by-process limitation, but rather a resulting structure having distinct and defined characteristics." However, the limitations are not a resulting structure having distinct and defined characteristics. The Applicant has made a general statement without pointing out and providing evidence as to how the structure has "distinct and defined characteristics." The structures are the same because they both have a rhodium layer (For Example: See Figure 2 and Column 5 Lines 5-15). The MPEP § 2113, states, "Even though product -by[-] process claims are limited by and defined by the process, determination of patentability is based upon the product itself. The patentability of a product does not depend on its method of production. If the product in product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product is made by a different process."

In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985)(citations omitted). A "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao and Sato et al., 190 USPQ 15 at 17 (CCPA 1976) (footnote 3). See also In re Brown and Saffer, 173 USPQ 685 (CCPA 1972); In re Luck and Gainer, 177 USPQ 523 (CCPA 1973); In re Fessmann, 180 USPQ 324 (CCPA 1974); and In re Marosi et al., 218 USPQ 289 (CAFC 1983) final product per se which must be determined in a "product by, all of" claim, and not the patentability of the process, and that an old or obvious product, whether claimed in "product by process" claims or not. Note that Applicant has the burden of proof in such cases, as the above caselaw makes clear. The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. See In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. See In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). Arguments are not evidence. Evidence (ex: declarations, affidavits or etc.) tends to prove or disprove the existence of an alleged fact (See Black's Dictionary). Finally, Applicant argues that "although the specification indicates along with the (CO2) groups, the carbon from the deposited saturated organo-rhodium monolayer is removed and a pure metallic rhodium layer forms on a surface of the substrate 20...Accordingly the limitation substantially pure metallic is disclosed in the specification." However, "substantially pure metallic" is not defined in the specification. Therefore, it is not limited to carbon and could encompass alloying metals. Additionally, the specification does not state that a "substantially pure metallic" is resulting instead it states that a "pure metallic" results (For Example: See Paragraph 32). The specification does not state that only a portion of the carbon is removed it states "carbon contamination is greatly reduced as carbon is removed with the use of oxygen" (For Example: See Paragraph 32).



Mary Wilczewski
Primary Examiner